

§803.02, first paragraph. Upon a finding that the elected species is patentable, the search should be extended to cover the non-elected species.

REMARKS

The Examiner has made claims 1-25 subject to a restriction requirement under 35 U.S.C. 121. The Examiner has divided claims 1-25 into four groups:

- Group I: Claims 1-22, drawn to compounds of formula I wherein n is 1 and R³ is (CR^{3'}CR^{3''})_r C₃₋₆ carbocyclic residue, compositions and methods of use.
- Group II: Claims 1-22, drawn to compounds of formula I wherein n is 2 and R³ is (CR^{3'}CR^{3''})_r C₃₋₆ carbocyclic residue, compositions and methods of use.
- Group III: Claims 1-22, drawn to compounds of formula I wherein n is 1 and R³ is (CR^{3'}CR^{3''})_r C₃₋₆ heterocyclic residue, compositions and methods of use.
- Group IV: Claims 1-22, drawn to compounds of formula I wherein n is 2 and R³ is (CR^{3'}CR^{3''})_r C₃₋₆ heterocyclic residue, compositions and methods of use.

Withdrawal of the restriction between Groups I-IV is respectfully requested.

According to MPEP §803, restriction is only proper if there are two or more claimed inventions and these inventions "are able to support separate patents and they are either independent (MPEP §806.04-§806.04(i)) or distinct (MPEP §806.05-§806.05(i))." In addition to being

independent or patentably distinct, there must be a serious burden placed on an Examiner if restriction is not required. MPEP §803.

However, in MPEP §803.02, an exception to the above restriction definition has been made for Markush-type claims. Applicants submit that the present Restriction Requirement is, in essence, an attempt to ignore the Markush-type claim exception and improperly turn a provisional election of species in a Markush-type claim into a restriction requirement. MPEP §803.02 specifically states that:

Markush-type claim[s] can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits.

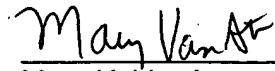
The reason given for the restriction is that the compounds of Group I-IV are structurally divergent, they do not belong to the same recognized class, and that art anticipating or rendering obvious one group would not necessarily do the same for the others. Yet, these statements merely show that a provisional election of species for examination purposes is the proper course as described in MPEP §803.02.

Applicants submit that the reasons offered by the Examiner are not sufficient to support a conclusion that a restriction requirement is warranted. Therefore, withdrawal of the restriction requirement is respectfully requested.

The application is now believed to be in condition for examination on the merits and notification thereof is respectfully requested.

Respectfully submitted,

Date: May 4, 2004

A handwritten signature in cursive script, reading "Mary VanAtten", written in dark ink.

Mary K. VanAtten
Attorney for Applicants
Registration No. 39,408
Telephone: 609/252-4379